Paper No. 10

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte MITCHELL M. JOHNS,
CHRISTOPHER A. TOLES, and WAYNE E. MARSHALL

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Appeal No. 1999-2487
Application No. 08/834,051

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ON BRIEF

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Before GARRIS, TIMM, and DELMENDO, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 1 and 3-11 which are all of the claims remaining in the application.

The subject matter on appeal relates to a process for the production of activated carbons from low-density lignocellulosic agricultural material and to the activated carbon produced by

this process. Appealed claims 1 and 9 are adequately representative of this appealed subject matter and read as follows:

1. A process for the production of activated carbons prepared from low-density lignocellulosic agricultural material comprising the steps of:

A. admixing a binder selected from molasses, coal tar or wood tar with the low-density lignocellulosic waste to form pellets, briquettes, or extrudates and converting them into a char;

B. contacting the charred low-density lignocellulosic material of step A with carbon dioxide or steam under conditions effective for production of an activated carbon; and

C. oxidizing the activated carbon of step B in air.

9. An activated carbon produced by the process of claim 1.

The references relied upon by the examiner in the rejections before us are:

Mehta	3,951,907	Apr. 20, 1976
Bürger et al. (Burger)	3,960,761	Jun. 1, 1976

González-Vilchez et al. (Gonzalez-Vilchez), "The Controlled Reaction of Active Carbons with Air at 350°C-I," Carbon, Vol. 17, pp. 441-446 (1979).

Claims 9-11 stand rejected under 35 U.S.C. § 102(b) as being anticipated by or alternatively under 35 U.S.C. § 103 as being obvious over Mehta.

Claims 1, 3, 4 and 7-9 stand rejected under 35 U.S.C. § 103 as being unpatentable over Gonzalez-Vilchez taken with Burger,

and claims 5 and 6 stand correspondingly rejected over these references and further in view of Mehta.

We cannot sustain any of the above noted rejections.

Concerning the section 102/section 103 rejection of product-by-process claims 9-11 over Mehta, the examiner expresses his position in the following manner on page 3 of the answer:

> Mehta teaches in col. 4 lines 25-40 rice straw to make active carbon. While not teaching the claimed process of making, any difference would have been obvious to one of ordinary skill in the art at the time of the invention because where the examiner has found substantially the same product as claimed in the art, the burden is upon the applicant to show a difference in the product, not on the examiner to show the same process; In re Brown 173 USPQ 685 and In re Marosi 218 USPQ 289.

Contrary to the examiner's above quoted statement, Mehta does not teach "in col. 4 lines 25-40 rice straw to make active carbon." As correctly indicated by the appellants in their brief, Mehta discloses a process of making silica from organic materials such as rice hulls or rice straw. While it is true that this product contains a small amount of residual carbon, nowhere does patentee teach that this carbon is in an activated form as required by the rejected claims. Moreover, although the examiner makes the unembellished statement that "Mehta treats the same feed in essentially the same manner as appellants and thus appears to make the same product" (answer, page 4), the examiner

points to nothing specific (and we find nothing independently) in patentee's disclosure to support the proposition that the residual carbon in Mehta's product would be in an activated form.

In light of the foregoing, it is apparent that the examiner has failed to provide any evidence or scientific reasoning to establish the reasonableness of his position that the residual carbon of Mehta would possess the characteristic of being activated as required by the rejected claims. Compare Ex parte Skinner, 2 USPQ2d 1788, 1789 (Bd. Pat. App. & Int. 1991). It follows that we cannot sustain the section 102/103 rejection of claims 9-11 of Mehta.

We also cannot sustain the examiner's section 103 rejection of claims 1, 3, 4 and 7-9 as being unpatentable over Gonzalez-Vilchez taken with Burger or his corresponding rejection of claims 5 and 6 as being unpatentable over these references and further in view of Mehta. As correctly indicated by the appellants in their brief, the applied prior art would not have motivated an artisan with ordinary skill "to use the binders of Burger in the process of Gonzalez-Vilchez" (answer, page 3) as proposed by the examiner. In this regard, the binders of Burger, to which the examiner refers, are taught by patentee for use with extensively carbonized material such as coal or coke (e.g., see

lines 45-56 in column 1 of Burger). This is significant because the materials such as almond shells used in the Gonzalez-Vilchez process plainly are not extensively carbonized materials. With respect to this last mentioned point, it is further significant that Burger expressly discloses molding and activating nutshells, which are analogous to the almond shells of Gonzalez-Vilchez, albeit via the use of a molding agent such as zinc chloride or phosphoric acid.

With these circumstances in mind, it is apparent that, if an artisan were to combine these references in order to form the almond shells of Gonzalez-Vilchez into the here claimed shapes, he would have used the aforementioned zinc chloride or phosphoric acid molding agents of Burger. Clearly these references provide no basis for combining the Gonzalez-Vilchez almond shells with the binders which Burger discloses for use with extensively carbonized materials such as coal or coke. It is apparent that the combination proposed by the examiner in this rejection is based upon impermissible hindsight derived from the appellants' own disclosure. W.L. Gore & Assoc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

The decision of the examiner is reversed.

REVERSED

Bradley R. Garris Administrative Patent Judge	)	
Catherine Timm Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
Romulo H. Delmendo Administrative Patent Judge	)	

BRG:tdl

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